

REMARKS

Restriction Requirement

Restriction has been required between the claims of Group I, claims 16-20 drawn to an aqueous-based composition; the claims of Group II, claims 21-24 drawn to an organic solvent-based coating composition; and the claims of Group III, claims 25-28 drawn to a process for coating a continuous metal sheet.

Applicants have elected with traverse to prosecute the invention of claims 16-20 directed to the aqueous-based composition. The traverse with regard to the claims of Groups II and III has been withdrawn and these claims have been canceled. An election of species has also been required under 35 U.S.C. 121. Accordingly, applicants have elected with traverse the following species, the absence of amines and the absence of corrosion inhibiting pigments set forth in claims 17 and 18, 19 and 20, respectively. However, applicants' traversal of the species rejection is retained. It is believed that a generic claim, i.e., claim 16, is allowable and that therefore applicants are entitled to claims to additional species which are written in dependent form and include the limitations of the allowed generic claim. Specifically, these additional species are set forth in claims 17 through 20.

Amendment to the Specification

The specification on page 1 has been amended to update the status of the parent application.

Rejection of the Claims

Claim 16 has been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 2, 9, 20 and 23 of U.S. Patent 6,641,923. The Examiner contends that although the conflicting claims are not identical, they are not patentably distinct from one another. The claims of the patent set forth a coating composition comprising a phosphated epoxy group-containing polymer, a curing agent, an electroconductive pigment, the reaction product of a boron-containing compound and a polysiloxane and a further boron-containing compound. The electroconductive pigment is dispersed in a binder comprised of an epoxy polymer and a curing agent in a ratio of from 0.5:1 to 9.0:1 (claim 2 of the patent). The Examiner points out that the claimed presence of water is not recited in the aforementioned claims of the patent; however, to the Examiner, it

would have been obvious to disperse the components of the coating into water to facilitate the ability to coat the composition without resorting to the use of environmentally hazardous volatile organic solvents.

The obvious type double patenting rejection is respectfully traversed. The Examiner's argument is based on a "one-way obviousness test" namely, whether the claims of the instant application would be obvious over the claims of the patent. It is submitted in the present case that the "two-way obviousness test" must be applied and when this test is applied, the claims of the instant application are patentably distinct from those of the patent. The instant application claims the benefit of a February 8, 2001 provisional application. The patent in question (U.S. 6,641,923) has a priority date of July 31, 2001, some six months after the priority date of the instant application. When an obvious-type double patenting rejection is made against the claims of an application from a later filed patent, a two-way obviousness test is applied when the applicant could not have filed the claims in a single application and there is an administrative delay. Clearly, applicants could not have filed the claims in the present application with the claims of the patent cited in the rejection. In addition, it was the Patent Office that controlled prosecution of the instant application preventing the claims of the present application from issuing before the claims of the patent. The source of delay was a restriction requirement in which the instant claims were restricted from the parent application and a final rejection in the parent application which had to be appealed before allowance was secured leading to the filing of the instant divisional application.

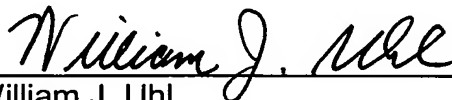
The Examiner's attention is directed to General Foods Corp. v. Studiengesellschaft Kohle GmbH, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992). In this case, the court elected not to hold the patentee accountable for delay in issuing the first-filed application until after the second-filed application issued as a patent, even where the patentee had intentionally refiled the first application as a continuation-in-part after receiving a Notice of Allowance indicating that all claims presented were patentable. See also In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991) where the court held that through no fault of applicant the claims in the later filed application issued first and an obvious-type double patenting rejection is improper in the absence of a two-way obviousness determination because the applicant does not have complete control over the rate of progress of a patent

application through the Office. While acknowledging the allowance of claims in the earlier-filed application would result in a timewise extension of an invention claimed in the patent, the court was of the view that the extension was justified under the circumstances of the case, indicating that a double patenting rejection would be proper only if the claimed inventions were obvious over each other -- a two-way obviousness determination.

In the present situation, a two-way obviousness test cannot be made. Even assuming that the Examiner is correct that it would be obvious to include water in the compositions of the claims of the patent, it clearly would not be obvious to include the two boron compounds and the polysiloxane in the claims of the instant application. Therefore, in view of the fact that a two-way obviousness test cannot be established, it is submitted that the double patenting rejection is improper and should be withdrawn.

In summary, it is felt that applicants' claims 16-20 are patentable and should be allowed. Should the Examiner have any questions concerning this response, he is urged to contact applicants' Pittsburgh attorney undersigned below for a telephonic interview to resolve the issues.

Respectfully submitted,

A handwritten signature in cursive script, reading "William J. Uhl", is written over a horizontal line.

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